

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Shell S. Simpson

Serial No.: 10/052,617

Filed: October 25, 2001

Group Art Unit: 2625

Examiner: Thomas, Ashish

Docket No. 10007679-1

For: **System and Method For Print-To-Mail Notification**

REPLY BRIEF RESPONSIVE TO EXAMINER'S SUPPLEMENTAL ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Supplemental Answer mailed February 5, 2008 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

This Reply is responsive to the "Examiner's Answer" issued on February 5, 2008. Given that that answer is the second answer issued by the Examiner and further given that the answer was issued after filing of Applicant's Reply Brief and is therefore responsive thereto, the "Examiner's Answer" of February 5, 2008 constitutes a "supplemental" examiner's answer.

The right to issue supplemental examiner's answers is provided by 37 CFR 41.43. As stated in 37 CFR 41.43(a)(1), the Examiner "may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief." However, as provided in 37 CFR 41.43(a)(2):

***A supplemental examiner's answer responding to a reply brief
may not include a new ground of rejection.***

37 CFR 41.43(a)(2) (emphasis added).

The Examiner has broken the above rule by issuing a new rejection in the supplemental examiner's answer issued February 5, 2008. On page 4 of that paper, the Examiner states "[p]lease note that new grounds of rejection, in regards to claims 19, 22, 23, 28, 29, 30, 31, and 32, are incorporated in this office action." Because the Examiner is not permitted to issue new rejections in supplemental examiner's answers as per 37 CFR 41.43(a)(2), the Examiner's new rejections are improper.

Applicant acknowledges the attempt to characterize the supplemental answer as not comprising a supplemental examiner's answer by the title "Examiner's Answer" and the statement that the answer is "in response to the appeal brief filed February 27,

2007." Applicant notes, however, that 37 CFR 41.43(a)(1) explicitly states that the Examiner "must acknowledge receipt and entry of the reply brief" submitted by the Applicant. Therefore, the Examiner cannot ignore Applicant's Reply Brief and issue new rejections under the guise of responding to Applicant's Appeal Brief instead of Applicant's Reply Brief.

In view of the above, the Examiner's new rejections are improper and Applicant will not respond to them. Applicant instead maintains the positions expressed in the original Reply Brief responding to the Examiner's arguments presented in the original Examiner's Answer issued on June 27, 2007. Applicant has reproduced the remarks from that Reply Brief in the following:

1. Determining that a Document has been Printed, Folded, and Sealed

Regarding the Examiner's argument on page 11 that Tammi's system "can" determine if folding and/or sealing later occurred, Applicant notes that Tammi does not actually state that Tammi's system does in fact determine if folding or sealing in fact occurred. Instead, Tammi describes tracking "the movement and location of each printed mail statement." *Tammi*, column 10, lines 20-24. Not described by Tammi is actually determining whether folding or sealing of that printed statement was successfully accomplished. For all the reader knows, Tammi's "sensing means" tracks the printed mail statement as it is sent to the devices that perform folding or sealing just like the other sensing means described by Tammi in column 4. Furthermore, Applicant notes that the mere fact that a certain action *may* result from a given set of circumstances is not sufficient to establish that a reference actually teaches that

limitation. See *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Here, the Examiner is hypothesizing as to what “can” happen in Tammi’s system with hindsight to Applicant’s claim limitations. Applicant respectfully submits that the Examiner’s rejections should be based on what the references actually teach or suggest and not what possibly could occur in view of Applicant’s own disclosure.

2. Notifying that a Document has been Printed, Folded, and Sealed

On page 13 of the Examiner’s Answer, the Examiner argues that Tammi teaches “generating notification information that identifies that the print-to-mail format document has been generated, thereby indicating that the document has been printed, folded, and sealed as a mailing” in column 10, lines 10-15. In particular, the Examiner appears to take the position that by tracking the position of printed mail statements, Tammi inherently teaches generating notification information that identifies that the print-to-mail format document has been generated.

Applicant disagrees with the Examiner’s conclusions. As before, those conclusions are not based upon the teachings or suggestions contained within the Tammi reference. Instead, the Examiner’s conclusions are based upon the Examiner’s suppositions as to what could possibly happen in Tammi’s system. When Tammi’s actual disclosure is considered, it is clear that no “notification information” is generated as to whether a print-to-mail format document has been printed, folded, and sealed as a mailing. Although Tammi does identify various sensing means, there is no reason to assume that the sensing means generate such notifications. Indeed, given that Tammi

explicitly states that the sensing means track “the machine cycle of each device” (*Tammi*, column 10, line 10-15), *Tammi*’s tracking may be performed for device maintenance purposes in terms of part replacement, replenishing consumables such as glue, and the like.

Irrespective of what purpose *Tammi*’s sensing means serve, the fact is that *Tammi* does not teach or suggest generating notification information that identifies that the print-to-mail format document has been generated. Applicant further notes that *Tammi* could have easily described such an action if *Tammi*’s system actually provided such notification. For example, as indicated by the Examiner earlier in prosecution of the instant application, *Tammi* describes in no uncertain terms that *Tammi*’s system “signals” a “computer means” when a printed mail statement is transferred from the printer to the post processing means. *Tammi*, column 4, line 60 to column 5, line 3. *Tammi* describes no such “signaling” in relation to the post processing that occurs after that point.

3. “Print-to-Mail Format Document”

On pages 13 and 14 of the Examiner’s Answer, the Examiner again alleges that *Tammi* teaches “print-to-mail format documents”. Regarding Applicant’s assertions that *Tammi* teaches no such documents, the Examiner argues that “the features upon which appellant’s relies are not recited in the rejected claim(s).” Applicant disagrees. Specifically, Applicant explicitly refers to the documents as “print-to-mail format” documents. The term “print-to-mail format” is a term of art that is known in the printing arts and cannot be ignored. Furthermore, Applicant even included the definition of

“print-to-mail format document” in the claims by that states that the print-to-mail format document is “generated by printing, folding, and sealing the document as a mailing”. Indeed, Applicant’s independent claims were intentionally amended to clarify what is meant by “print-to-mail format document” and to distinguish such a document from a mere sheet of paper that is stuck in an envelope as described by Tammi. The Examiner, however, has chosen to disregard the modifier “print-to-mail format” as well as the phrase “generated by printing, folding, and sealing the document as a mailing”.

With further regard to the phrase “generated by printing, folding, and sealing the document as a mailing”, Applicant notes that Tammi clearly does not teach or suggest such actions. In particular, Tammi’s printed mail statement is not folded and sealed “as a mailing”. Instead, as stated above, Tammi’s printed mail statement is placed in an envelope which is sealed. Therefore, Tammi’s document is not itself sealed as a mailing.

As to the Examiner’s allegation that Applicant is trying to “read limitations into the claims,” it is clear that Applicant is not. First, as stated above, Applicant explicitly added the definition of “print-to-mail format document” in the claims. Second, Applicant is not seeking to add new limitations from the specification into the claim. To the contrary, Applicant is asking that a term of art used to describe an explicit claim element, a term of art that is explicitly defined by Applicant in the specification, be used when judging whether or not the prior art teaches that claim element. Under the Examiner’s view, the specification is completely irrelevant to the examination process and the claims should be judged in a vacuum. Clearly, under such circumstances, claim terms can be assigned nearly any meaning that would enable the Examiner to reject the claims. To

permit the Examiner to make up his own definitions for claim terms that directly contradict Applicant's explicit definitions is clearly unjust.

4. Notifications After Printing, Folding, and Sealing

On page 15, the Examiner again argues that Tammi teaches providing a notification after printing, folding, and sealing. As stated above, Tammi simply does not describe such "notifications." Again, although Tammi discusses "signaling" a "computer means" as to printed mail statements being transferred to post processing means, Tammi does not describe such signaling with respect to the post processing processes.

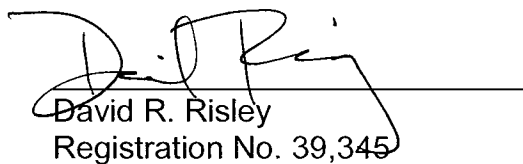
5. Claims 18, 21, 26-29, and 32

Regarding the Examiner's arguments as to claims 18, 21, 26-29, and 32 provided on pages 15 and 16 of the Examiner's Answer, Applicant refers to the points made above in sections 1 and 2.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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